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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,703	04/13/2004	Masahiro Iwahara	251737US0XDIV	2932
22850	7590	02/09/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHIPPEN, MICHAEL L	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,703

Applicant(s)

IWAHARA ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION***Claim Rejections - 35 USC § 102***

Claims 12, 13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,308,404, USP 4,391,997 or USP 4,400,555 each optionally in view of USP 5,777,180 for reasons of record. The fact that the references do not disclose the claimed range of 20 to 65 mol% for a methanol concentration in the range of 700 to 8000 ppm is simply of no moment. The claims also read on a modification of 10 to less than 20 mol% with a methanol concentration below 250 ppm, which reads on the prior art processes.

Claim Rejections - 35 USC § 103

Claims 12, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,308,404, USP 4,391,997 or USP 4,400,555 each optionally in view of USP 5,777,180 for reasons of record and reasons given above.

Claims 12, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,780,690 or JP-10-175898 each optionally in view of USP 4,391,997 and USP 4,400,555 for reasons of record. Applicants' argument with respect to the instant rejection is not clear but apparently relies upon their argument stated above that the references does not disclose the claimed range of 20 to 65 mol% for a methanol concentration of 700 to 8000 ppm. This is simply of no moment as pointed out above since the claims read on modification of 10 to less than 20 mol% with a methanol concentration below 250 ppm which reads on the prior art processes.

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Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-10-251179 optionally in view of USP 5,780,690, USP 4,391,997 and USP 4,400,555 for reasons of record. Contrary to applicant's assertion, the secondary references do teach the use and advantages of multistage reaction systems as pointed out in the last Office action. The fact that the example of JP-10-251179 exemplifies the use of 10,000 ppm of methanol does not distinguish the claims from the prior art. The reference is not limited to its examples. Applicant's reliance upon their examples given in the instant specification is noted but not found persuasive of patentability. The examples are not considered to be representative of the prior art nor are they commensurate in scope with the claims. Comparative Example 2 of the specification differs from the prior art example in several ways such as to the sulfur promoter used and the amount modification of the ion exchange resin and the like. None of the instant examples is representative of the claimed process closest to the prior art. Nor do any of the examples differ only as to the amount of the methanol present. Moreover, it is clear from the teaching of the prior art that the amount of modification can be optimized for a particular methanol concentration.

Double Patenting

Claims 8-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/433155 in view of USP 4,400,555 for reasons of record. Applicant's conditional willingness to file a terminal disclaimer is not seen to address the rejection in a timely manner.

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Claims 8-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of USP 6,740,784 for reasons of record. Applicant's conditional willingness to file a terminal disclaimer is not seen to address the rejection in a timely manner.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
February 7, 2005


MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621